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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,993	07/07/2003	Edward Allen Covington	DANA-76C1	9821

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/612,993	Applicant(s) COVINGTON, EDWARD ALLEN	
	Examiner Matthew O Savage	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-37 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 28-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of: _____
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-7-03</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 28-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to line 4 of claim 28, the concept of the filter media being disposed at the open top portion of the oil pan to close the open top lacks basis in the original disclosure and is considered new matter.

Concerning lines 6-7 of claim 28, the concept of the filter media having sufficient resistance to flow of oil therethrough to retain the oil on the dirty side of the filter media lacks basis in the original disclosure and is considered new matter.

Regarding lines 2-4 of claim 31, the concept of the oil being temporarily retained in the valleys on the dirty side of the filter media until pulled through the filter media by suction applied to the suction passageway lacks basis in the original disclosure and is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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With respect to claim 28, the limitation "filter media disposed at the open top portion of the oil pan to close the open top" on lines 4-5 of claim 28 is considered misdescriptive since the original drawing Figures disclose the filter media as being spaced downwardly from the open top portion of the pan as opposed to being at the open top.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-30, and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Jagdmann.

With respect to claim 28, Jagdmann discloses an oil pan 20 having a space 38 between a floor and an open top portion 36, a filter media 56 disposed at the open top portion of the oil pan to close the open top (see FIG. 11), the filter media media 56 having a dirty side facing upwardly and a clean side facing the floor, and a suction passageway (e.g., defined by conduits 50 or 57) extending from the space in the oil pan to a location outside of the oil pan, the suction connection being connected to a suction pump capable of pulling the oil through the filter media into the space and conveying the oil out of the pan for recirculation (see lines 52-59 of col. 3). Jagdmann fails to specify the filter media having sufficient resistance to flow of oil therethrough to retain oil on the dirty side of the filter media, however, such a property is considered inherent in the case

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where the oil was congealed during extremely cold weather or when the filter media has been sufficiently loaded with contaminants.

Claims 29 and 30 relate to intended use and carry no patentable weight.

Concerning claim 35, Jagdmann discloses the filter media as being separable from the pan so as to be replaceable since it is removably clamped between the pan and the transmission casing (see lines 5-8 of col. 4).

Regarding claim 36, Jagdmann discloses the filter media as being retained within a frame (e.g., formed by rubber compound or heavy resin at the margin of the cloth, see from line 74 of col. 3 to line 2 of col. 4).

As to claim 37, Jagdmann discloses the suction passageway as being a return pipe 52 that is part of the oil pan.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagdmann in view of Taniguchi.

With respect to claim 31, Jagdmann fails to specify the filter media as being pleated. Taniguchi discloses an analogous filter that is pleated (see FIG. 4) and teaches that such a configuration provides a greater filtering area for the same flow face area as compared to a flat filter thereby increasing the life of the filter (see lines 21-26). It would

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have been obvious to have modified the filter of Jagdmann so as to have included a pleated filter media as suggested by Taniguchi in order to increase the filtering area of the filter.

Claims 32-34 relate to intended use and carry no patentable weight.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 6:00am-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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M. Savage

Matthew O Savage
Primary Examiner
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February 3, 2004